

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s): Takaaki AMANO
Appl. No.: 09/863,877
Conf. No.: 9471
Filed: May 23, 2001
Title: ADVERTISEMENT INFORMATION SUPPLYING SYSTEM
Art Unit: 3688
Examiner: Jean D. Janvier
Docket No.: SCET 18.699 (100809-16253)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Sir:

Appellants submit this Reply Brief in response to the Examiner's Answer dated August 20, 2008.

I. STATUS OF THE CLAIMS

Claims 1 and 4-10 are pending in the above-identified patent application. Claims 1 and 4-10 have been rejected. An Appeal Brief was filed June 2, 2008, where Appellant demonstrated the deficiencies of the pending rejections. The Office replied with an Examiner's Answer on August 20, 2008, maintaining the rejections. This Reply brief maintains Appellant's original position that the Office's reasoning in rejecting the present claims is erroneous and should be reversed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claim 4 was rejected under 35 U.S.C. §112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter regarded as the invention.
2. Claims 1 and 4-10 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.
3. Claims 1 and 4-10 were rejected under 35 USC §102(b) as being allegedly anticipated by Golhaber (US Patent No. 5,794,210).

III. ARGUMENT

A. THE REJECTION OF CLAIM 4 UNDER 35 U.S.C. §112, SECOND PARAGRAPH SHOULD BE REVERSED BECAUSE THE CLAIM PARTICULARLY POINTS OUT AND DISTINCTLY CLAIMS THE SUBJECT MATTER REGARDED AS THE INVENTION

In pertinent part, independent claim 1 recites:

display point degree determining means for determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement (emphasis added).

Turning to dependent claim 4, the claim language recites:

The advertisement supplying system as claimed in claim 1 wherein: a minimum value of the point degree to be displayed is equal to 0.

As is apparent from the claim language and Appellant's earlier argument, the claim does not indicate that the point degree *never* decreases to zero. Rather, claim 4 recites that "*a minimum value*" of the point degree to be displayed is equal to 0, which is consistent with the feature of claim 1 relating to the adjustment to the display point degree for the first selection of the advertisement. Accordingly, the claim language satisfies the statutory requirements of 35 U.S.C. §112:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available . . . Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might

desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

See MPEP § 2173.02.

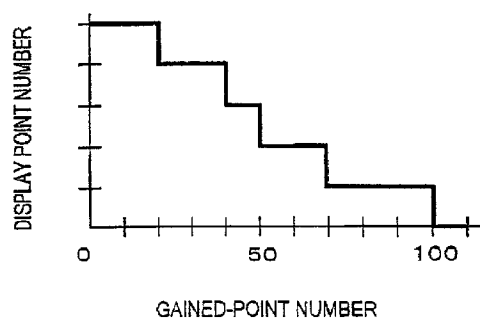
B. THE REJECTION OF CLAIMS 1 AND 4-10 UNDER 35 U.S.C. §112, FIRST PARAGRAPH, SHOULD BE REVERSED AS THE CLAIMS ARE ENABLED AND COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT

With regard to the written description, the Examiner's Answer (page 4) states:

Here, although fig. 5 appears to show that the display point degree can be equal to zero (0), however, the specification, including the portions mentioned by the Appellant, does not immediately support that "the display point degree does not decrease to zero for the subsequent display of the advertisement information ... ". To this end, the claims will be given their broadest interpretation in accordance with the specification.

It is apparent from the above that the Examiner has ignored Appellant's arguments, submitted on p. 8-9 of the Brief, almost entirely. While Fig. 5 is relevant to the present discussion, that main point of Appellants argument was that Fig. 12, along with p. 35, line 5 - p. 37, line 5 discloses that if a user displays the same banner advertisement many times, then "the displayed point (namely, gained-point number) is *gradually* decreased." Looking at Fig. 12, it can be seen that a display point number decreases as the gained point number increases (note zero axis in graph):

FIG.12



Accordingly, the display point number does not decrease to zero immediately after the gained-point number rises above zero. This is something that is easily understood by one having ordinary skill in the art. The arguments put forth on pages 10-12 in the Examiner's Answer provide no additional support for the Examiner's position. Accordingly, Appellants maintain this rejection is improper and should be reversed.

With regard to enablement, the Examiner's Answer provides the following:

In fact, the relationship between the "display point degree", the "points themselves", "point-appearing time" and "point-appeared time" is not clear and the portions mentioned by the Appellant do not clarify that either. In general, the specification simply repeats what it is shown in the drawings. Further, it is unclear how the "point degree" is being computed or determined with respect to the points. The relevance of the "display point degree", as far as the subject matter or patentability is concerned, is not defined so as to enable one of ordinary skills, in the art to practice the invention or to at least apply a point degree in combination with a point assignment to a banner ad (metes and bounds problem). Moreover, the Examiner notes that the "point degree" or "display point degree" is not a factor/multiplier or some kind of indexing. In short, the significance or contribution of the "point degree" to the claims is not clearly or immediately appreciated. To this end, the claims will be given their broadest interpretation or the "display point degree" is interpreted as "point display".

Appellant respectfully submits that it becomes difficult, if not impossible, to effectively respond to Examiner concerns that are vaguely worded and rooted in a convoluted understanding of the Appellant's disclosure and the requirements of 35 U.S.C. §112. As was already pointed out by the Appellants, specific terms explicitly mentioned by the Examiner - "points themselves," "point-appearing time," and "point-appeared time" - *do not even appear in the language of the presently contested claims*. Moreover, the term "points themselves" *does not appear anywhere in the present disclosure*. MPEP §2164 clearly provides that "[t]he enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent" (emphasis added). As the rejection is based on language that doesn't appear in the claims, Appellant maintains the rejection is improper and should be reversed. As a side note, Appellant notes that the "Point Producing Process Operation" embodiment disclosed in the present

specification (see [00129-139], see also [0089-95]), clearly discloses the relationship among the various terms noted by the examiner.

C. THE REJECTION OF CLAIMS 1 AND 4-10 UNDER 35 U.S.C. §102(B), IS IMPROPER AS THE GOLHABER REFERENCE FAILS TO TEACH EVERY LIMITATION SET FORTH IN THE PRESENT CLAIMS

After further review of the Examiner's Answer, no new substantive arguments were put forth in the body of the Answer, as it appears this section was copied wholesale from the earlier Office Action (compare p. 5-10 of the Answer to p. 5-10 of the Office Action dated July 6, 2007). Accordingly, Appellants stand on the merits of the arguments previously put forth in the Brief.

With regard to the comments put forth in pages 12-13 of the Answer, the examiner explains the current rejection in the following manner:

Examiner reviewed the claimed invention and then realized that not only "the display point degree does not decrease to zero for the subsequent display of the advertisement information ..." is not immediately supported in the specification, but also it is at best a non-functional and non-descriptive material.

See p. 12, Examiner's Answer, last paragraph. The fact that the examiner deems a claim element as "not immediately supported" does not obviate the examiner from considering the element (or a reasonable interpretation thereof) when considering the prior art (see MPEP § 2164.04). Here, the Examiner has either ignored the element or applied an improper interpretation that is inconsistent with the present disclosure (the various explanations for justifying the rejection in the present proceedings make it difficult to determine which is the case). Additionally, the notion that individual elements may be randomly chosen in isolation and classified as "non-functional and [non-]descriptive" material is false. Firstly, it is a basic tenet of claim construction that the claim be viewed *as a whole*. Examiners have no right to "pick and choose" elements not to their liking and simply ignore them in light of the prior art. Second, the concept of "nonfunctional descriptive material" goes toward statutory subject matter (35 U.S.C. §101) and not claim interpretation when comparing against the prior art (see MPEP § 2106.01).

Accordingly Appellants maintain that the rejection is improper and should be reversed. As a side note, the Examiner submits that all previous office actions are "null and void and cannot be incorporated or argued here by reference." To the extent that any "examiner

estoppel” exists, Appellants agree. However, the previous office actions are indeed germane when they begin to demonstrate an inability or unwillingness on behalf of the Office to properly analyze the given claims and to apply them against the statutory requirements of 35 U.S.C. §101 *et seq.* In this case, it is becoming apparent to the Appellant that an effective resolution of the present issues may only be had with this Board, given the positions taken by the Examiner in the present examination.

IV. CONCLUSION

Appellants respectfully submit that Claims 1 and 4-10 are allowable for the reasons previously discussed. Accordingly, Appellants respectfully submit that the rejections under 35 U.S.C. §112 and §102(b) are erroneous in law and in fact and should therefore be reversed by this Board.

The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 50-1290. If such a deduction is made, please indicate the attorney docket number SCET 18.699 (100809-16253) on the account statement.

Respectfully submitted,

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